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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,579	12/19/2001	Patrick R. Clark	01-331	3272
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CATERPILLAR/FINNEGAN, HENDERSON, L.L.P.			EXAMINER	
901 New York Avenue, NW			BATES, KEVIN T	
WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER
			2153	
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			01/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/028,579

Applicant(s)

CLARK ET AL.

Examiner

Kevin Bates

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

This Office Action is in response to a communication made on October 31, 2007.

Claims 1-54 have been cancelled.

Claim 55 has been amended.

Claim 56-62 have been newly added.

Claims 55-62 are pending in this application.

Examiner's Note

In the interest of expedited prosecution, the Examiner would like to note that several of the present claims (i.e., 59-62) use functional language to describe claim elements. For example, the terms "configured for", "configured to", "enabled for", "adapted for", and "adapted to" raise questions as to the limiting effect of the functional language that follows them. The Examiner recommends amending the claims to contain positive recitations of the actions performed by the claim elements, rather than merely stating that the elements are "**configured to**" perform some future act. In the event that a hardware element is intended to contain software, which when executed, causes the hardware element to perform a function, the language of the claim should clearly express that relationship.

In the interest of expedited prosecution, all of these limitations have been rejected below, but Applicant is encouraged to amend the system/apparatus claims so that **the claimed functions are positively recited, to ensure that those limitations may be given patentable weight.**

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 59-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a computer based system comprising software applications and in the specification, the "system" is described as being a computer application (see ¶ 08, 24, and 85). So since the system has at least one embodiment directed at a software only application, then the claims are software per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55 and 59 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims recite the limitation "equipment a customer wishes to lease or purchase." The words wishes is a very indefinite confusing since "wishing" is more of a mental process of the customer and it is unclear how a computer system or based method is aware of the client's mental processes. It would

be must clearer if the limitation read something more concrete like the equipment that the customer indicates or something of that sort.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 55-62 are rejected under 35 U.S.C. 102(e) as being anticipated by

Tams (7184978).

Regarding claims 55 and 59, Tams teaches a computer based method for retrieving one or more financing documents associated with a purchase or lease of equipment, comprising:

storing, for each of a plurality of financing form documents, selection rules (Column 7, line 61 – Column 8, lines 37) which determine the conditions under which the each document is to be included in a documentation package associated with the purchase or lease of equipment (Column 16, lines 10 – 31);

receiving transaction information including equipment a customer wishes to lease or purchase and payment information associated with the lease or purchase (Column 7, lines 45 – 54);

based on the transaction information and the selection rules, automatically selecting one or more of the financing form documents to be retrieved and used in financing the purchase or lease of equipment (Column 8, lines 53 - 64); and

providing the one or more selected financing form documents to a computer for use in financing the purchase or lease of equipment (Column 15, line 64 – Column 16, line 9).

Regarding claims 56 and 60, Tams teaches the method of claim 55, wherein automatically selecting depends on one or more of: insurance information associated with the equipment, a location of a dealer associated with the equipment, and a location of a customer purchasing or leasing the equipment (Column 8, lines 10 – 13; Column 19, lines 25 – 31).

Regarding claims 57 and 61, Tams teaches the method of claims 55 and 59, wherein providing the one or more selected financing form documents includes providing a plurality of selected financing form documents (Column 16, lines 10 – 31) to the computer for use in financing the purchase or lease of equipment.

Regarding claims 58 and 62, Tams teaches the method of claims 55 and 59, wherein the one or more financing form documents are selected from one or more of: an insurance form, and a form describing the equipment for which a contract is being drafted (Column 16, lines 10 – 31).

Response to Arguments

Applicant's arguments with respect to claims 55-62 have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Notes on Claim Interpretation

To make clear the interpretation of the claim, the examiner will like to point out the following issues:

In claim 55:

In line 2, "one or more financing documents associated with a purchase or lease of equipment". The limitation of the documents "associated" with something is a label for the documents and does not, in any way, limit the financing documents. This is also true for a documentation package in line 7, and lease or purchase and payment information in line 10.

In line 12, "financing form documents to be retrieved and used in financing the purchase or lease of equipment." Anything that will be done, such as "to be retrieved and use" are not actual steps in the claim, thus do not occur, and as result does not have to occur in any prior art used.

In line 15 "documents to a computer for use in financing the purchase or lease of equipment." The idea that the limitation is "for use in" some environment does not limit the claim to that environment and only demonstrates an intended use and not a functional description.

There are also similar matters of these issues located in claims 56, 58, 59, and 60.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 7047491 issued to Schubert, because it teaches extracting lease information from a database.

U. S. Patent No. 6490601 issued to Markus, because it teaches creating form documents.

U. S. Patent No. 5870719 issued to Maritzen, because it teaches creating financing documents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Kevin Bates
January 23, 2008